

REMARKS

I. Brief Procedural History

In the Final Office Action of December 23, 2006, Examiner rejected claims 1, 4, 7, 10-13, and 17 pursuant to 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,597,299 to Jon in view of U.S. Patent No. 5,096,414 to Zellweger. In addition, claims 2, 3, 5, 6, 8, 9, 14 and 15 were objected to as being dependent on rejected base claims, but Examiner indicated that these claims would be allowable if rewritten in independent form to include all the limitations of the base claims.

Accordingly, in the Response of April 26, 2006, Applicant canceled claims 1, 4, 7, 10-13, and 17. The remaining claims were rewritten as suggested by Examiner. Specifically, claims 2 and 3 were rewritten in independent form to include all the limitations of claim 1. Claims 5 and 8 were not amended because they depend on claim 2, which was rewritten in independent form. Likewise, claims 6 and 9 were not amended because they depend on claim 3, which was rewritten in independent form. Claims 14 and 15 were rewritten in independent form to include all the limitations of claim 13.

In the Response of April 26, 2006, Applicant amended claim 16 in the same manner as claims 14 and 15, by rewriting claim 16 in independent form to include all the limitations of claim 13. However, in the Advisory Action of May 23, 2006, Examiner indicated that the amendment to claim 16 “would require further consideration and/or search and raises the issue of new matter.” Accordingly, Applicant has canceled claim 16.

II. Amendments to the Claims

The amendments herein are made to address certain inconsistencies in the claims.

A. Background

This is a reissue application from U.S. Patent No. 5,897,307 (hereinafter the “‘307 patent”). The ‘307 patent was issued April 27, 1999 and this broadening reissue was filed April 27, 2001.

The ‘307 patent is directed to two embodiments. In the first embodiment as shown in Figures 2-4, there are “two circular discs 53, 54, each having a glossy circumferential surface and a diameter approximately equal to that of the striking wheel 52, are integrally formed at the two sides of the striking wheel 52.” *See* Col. 5, lines 24-37 (emphasis added). In the second embodiment as shown in Figures 5-7, “the gaps between two sides of the striking wheel 52 and the two bent-edge members 63, 64 are filled by a first and a second protecting bent-edge member 63’, 64’ of the wind shield 60.” *See* Col. 5, lines 60-63. Further, “[s]ince the two protecting bent-edge members 63’, 64’ are inwardly extended to increase their width until abutting to the two sides of the striking wheel 52’, the two circular discs 53’, 54’ can thus be reduced their diameters symmetrically for further decreasing the manufacturing cost and reinforcing the axle 52’.” *See* Col. 6, lines 51-60.

Although the ‘307 patent disclosed two embodiments, the claims recited conflicting limitations for both embodiments. For example, in claim 1 of the ‘307 patent:

1. A disposable lighter, comprising:
....an ignition device comprising a flint and a striking wheel ... **wherein said striking wheel further comprises two circular discs integrally formed at said two sides of said striking wheel, each of said circular discs having a glossy circumferential surface and a width equal to each of said two gaps formed between said first and second supporting walls and said striking wheel; and**

a U-shaped wind shield mounted on said first and second supporting walls to cover said gas nozzle and said first and second supporting walls, said wind shield having an all around vertical U-shaped side wall which has a round end portion and two wing portion extending from said round end

portion ... so that said striking wheel is sidewardly covered by said two wing portions of said windshield, wherein said first and second bent-edge members of said wind shield are respectively and inwardly extended until abutting two sides of said striking wheel to form two protecting bent-edge members in order to cover two gaps formed between said striking wheel and said first and second supporting walls for better striking contact by increasing a contact area with a user's thumb.

See claim 1 of '307 patent (bold language at Col. 7, lines 42-47 and Col. 8, lines 1-9). In other words, claim 1 of the '307 patent conflictingly recited both the first *and* second embodiments.

When the reissue application was filed, two bases for the reissue were noted: 1) internal inconsistencies in the claims were inadvertently made when the claims were combined in original prosecution; and 2) patentee claimed less than he had the right to claim. *See* Reissue Application Declaration by the Inventor, submitted May 23, 2001. And in a subsequent Response to Office Action dated March 22, 2004, submitted in conjunction with a corrected Declaration, it was noted:

Specifically, the declaration refers to Claim 1 of the original application. Claim 1 is inconsistent in that it claims two separate embodiments of the invention that should have been claimed as separate dependent claims. Specifically, Col. 7 ll. 42 through 47 and Col. 8 ll. 3-8 describe two separate embodiments of the invention and relate to FIGS. 4 and 7, respectfully, and should not be included together in Claim 1.

However, the claims deemed allowable still contain the inconsistent language directed to the two embodiments.

B. Amendments

As noted above, claims 2 and 3 were previously rewritten in independent form to include all the limitations of claim 1. However, as rewritten, claim 2 contained certain inconsistencies. For example, claim 2 recites "an ignition device comprising a flint and a striking wheel, ... wherein said striking wheel further comprising two circular discs located at two sides of said

striking surface, each of said circular discs having a circumferential surface and positioned within each of two gaps formed between said first and second supporting walls and said striking wheel...”. This is inconsistent with the limitation that “said wing portions forming a curved corner which has a curvature matching with at least a quarter of a circumference of said striking wheel, *so that said striking wheel is sidewardly covered by said two wing portions of said wind shield, wherein said first and second bent-edge members of said wind shield are respectively and inwardly extended until abutting two sides of said striking wheel to form two protecting bent-edge members for better striking contact by increasing a contact area with a user's thumb.*” (emphasis added). Moreover, that the wing portions have bent-edge members “*inwardly extended until abutting two sides of said striking wheel to form two protecting bent-edge members*” is further inconsistent with the limitation that “wherein each of said circular discs has a diameter equal to that of said striking wheel.” In sum, if each of the circular discs has a diameter equal to that of said striking wheel as shown in Figure 1 exemplifying the first embodiment, then the bent-edge members could not extend inwardly to abut the two sides of the striking wheel to form two protecting bent-edge members.

In order to resolve this inconsistency in claim 2, Applicant has deleted the claim language: “*so that said striking wheel is sidewardly covered by said two wing portions of said wind shield, wherein said first and second bent-edge members of said wind shield are respectively and inwardly extended until abutting two sides of said striking wheel to form two protecting bent-edge members for better striking contact by increasing a contact area with a user's thumb.*” Further in this regard, Applicant has deleted dependant claim 5, which depended from claim 2.

Similarly, Applicant has amended claim 14 in the same manner as claim 2.

It is submitted that the claims as amended more clearly and distinctly claim the two separate embodiments described in the specification. By these amendments, Applicant has merely claimed what Examiner has previously indicated to be allowable subject matter.

CONCLUSION

The Examiner is respectfully requested to reconsider his position in view of the amendments and remarks made herein. It is believed that claims 2, 3, 6, 8, 9, 14 and 15 have been placed in condition for allowance, and such action is respectfully requested.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at (310) 777-8399.

If any additional fees are required as a result of this amendment, or any credit needs to be made for overpayment of fees, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 500703.

Respectfully submitted,

TROJAN LAW OFFICES
By

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/s/ R. Joseph Trojan

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